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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

09/714,997

11/20/2000

Robert C. Ross, Jr.

36956-168147

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06/15/2006

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EXAMINER

NEURAUTER, GEORGE C

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/714,997

Applicant(s)

ROSS, JR., ROBERT C.

Examiner

George C. Neurauter, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claims 1-20 are currently presented and have been examined.

Response to Arguments

Applicant's arguments with respect to claims 9-20 have been considered but are moot in view of the new ground(s) of rejection.

It is noted that the Applicant has failed to point to the specification in order to show the support for such amendments that have been made to the claims. Therefore, the Examiner will rely on the exact wording of the amended subject matter within the specification to determine proper support for these amendments. A general search for this wording within the specification wherein the user is unaware of a location of said user-assignable personal file folder in any file folder hierarchy was not found. The Applicant is requested to specifically point out the specific page and line and/or paragraph numbers and/or figures where such support for these amendments are disclosed within the specification.

Claim Objections

Claims 12 and 13 are objected to because of the following informalities:

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Claim 12 recites "...associated with the sender of any read receipt report..." This limitation should read "...associated with the sender of a read receipt report..."

Claim 12 also recites "...from the sender of said read receive report..." This limitation should read "...from the sender of said read receipt report..." in order to avoid antecedent basis issues.

Claim 13 recites "messageail". This should be "message".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10 and 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

MPEP 2173.05(i) states:

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"Any negative limitation or exclusionary proviso must have basis in the original disclosure...Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement."

Claims 10 and 18 recite "...without the user being aware of a location of said user-assignable personal file folder in any file folder hierarchy". This negative limitation was not described within the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10, 13, and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 18-20 recite "without the user being aware of a location of said user-assignable personal file folder in any

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file folder hierarchy". It is unclear how the user can be unaware of a location of a personal file folder in a folder hierarchy when the claim positively recites that the personal file folder is "user-assignable" since, in order for the folder to be assigned by the user, the user would have to be aware of the folder's location in order to distinguish and select the personal file folder.

Claim 13 recites "...said read receipt report is a dynamic, active read receipt report..." It is unclear how the report is "dynamic" and/or "active" since the claim does not positively recite what functions the report does in order to embody these features.

Claim Interpretation

Claim 17 recites obviating a need to drag and drop previously received messages on a folder. This clause simply expresses the intended result of process steps positively recited, therefore, this clause has not been given patentable weight. See MPEP 2111.04.

Claims 10 and 18 recite "without the user being aware of a location of said user-assignable personal file folder in any file folder hierarchy". This limitation will be interpreted wherein the user is unaware of the file folder hierarchy that is

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inherent within the operating system of the electronic message system.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 9, 10, 14, 17, and 18 are rejected under 35 U.S.C. 102(a) as being anticipated by "Microsoft Outlook 2000 Step by Step" ("Outlook 2000").

Regarding claim 9, "Outlook 2000" discloses an electronic message system comprising:

A user selectable save message instruction operative to automatically store in one of one or more user selected user-assignable personal folders a user selected previously received message ("existing e-mail message"), wherein said user selected user-assignable personal file folder is associated with a sender of said previously received message, tagged by one of an email address or a username of the sender of said message. (page 78, specifically "(2) In the SBS Practice Inbox Information viewer, click Lee Wong's RE: New Sales Initiative e-mail message."; page

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79, specifically "(5) If necessary, in the third box, click the drop-down arrow, and then select Miller Textiles (6) Click the Create button. A message box appears, telling you that the rule will be applied to new e-mail messages and prompting you to apply the same rule to other e-mail messages in your Inbox from Mr. Wong. (7) Click Yes. Next to the Create button, *Done!*

Appears on the screen. Now all existing e-mail messages from Lee Wong are moved to the Miller Textiles folder..."

Regarding claim 10, "Outlook 2000" discloses the system according to claim 9, wherein said user-selected previously received message received from the sender is automatically stored in said user selected one of said one or more of said user-assignable personal file folders, upon user selection of at least one of a command and/or user interface element by the user without the user being aware of a location of said user-assignable personal file folder in any file folder hierarchy.

(page 79, specifically "(6) Click the Create button. A message box appears, telling you that the rule will be applied to new e-mail messages and prompting you to apply the same rule to other e-mail messages in your Inbox from Mr. Wong. (7) Click Yes. Next to the Create button, *Done!* Appears on the screen. Now all existing e-mail messages from Lee Wong are moved to the Miller Textiles folder..."

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Regarding claim 14, "Outlook 2000" discloses the system according to claim 10, wherein said user interface element comprises at least one of an icon and/or a button. (page 79, specifically "(6) Click the Create button. A message box appears, telling you that the rule will be applied to new e-mail messages and prompting you to apply the same rule to other e-mail messages in your Inbox from Mr. Wong. (7) Click Yes.")

Regarding claim 17, "Outlook 2000" discloses the system according to claim 9, wherein the system is operative to rapidly store a plurality of user-selected previously received messages in one of said user-assignable personal file folders associated with said sender of said previously received messages, obviating a need to drag and drop said previously received messages on said folder. (page 79, specifically "Next to the Create button, Done! Appears on the screen. Now all existing e-mail messages from Lee Wong are moved to the Miller Textiles folder...")

Regarding claim 18, "Outlook 2000" discloses a machine-readable medium that provides instructions, which when executed by a computing platform, cause said computing platform to perform operations comprising a method comprising:

receiving a user selected instruction to store a previously received message in a user selected one of one or more user assignable personal file folders associated with a sender of

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said previously received message, tagged by one of an email address or username of the sender of said message, wherein said instruction comprises at least one of a command and/or a user interface elements and storing in said folder, said message, without the user having to know a location in a file folder hierarchy of said user-assignable personal file folder. (page 78, specifically "(2) In the SBS Practice Inbox Information viewer, click Lee Wong's RE: New Sales Initiative e-mail message."; page 79, specifically "(5) If necessary, in the third box, click the drop-down arrow, and then select Miller Textiles (6) Click the Create button. A message box appears, telling you that the rule will be applied to new e-mail messages and prompting you to apply the same rule to other e-mail messages in your Inbox from Mr. Wong. (7) Click Yes. Next to the Create button, *Done!* Appears on the screen. Now all existing e-mail messages from Lee Wong are moved to the Miller Textiles folder...")

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

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the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11, 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Outlook 2000".

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Regarding claim 11, "Outlook 2000" discloses the system according to claim 9.

"Outlook 2000" does not expressly disclose wherein the system is operative to automatically create a new one of said user assignable personal file folders, automatically tagged to at least one of the email address of or the username of the sender of said previously received message when no user assignable personal file folder exists for the sender of said message, however, "Outlook 2000" does disclose creating a new one of said user assignable personal file folders, automatically tagged to at least one of the email address of or the username of the sender of said previously received message when no user assignable personal file folder exists for the sender of said message (page 72, specifically "(2) In the SBS Practice Inbox Information viewer, click the RE" New Sales Initiative e-mail message from Dale Carter..."; page 73, specifically "(5) On the Ways to Organize SBS Practice Inbox panel, click the New Folder button located in the upper-right corner of the screen. The Create New Folder dialog box appears...In the Folder List, a new folder named Miller Textiles appears as a subfolder...In the Ways to Organize SBS Practice Inbox panel, Miller Textiles appears in the Move Message Selected Below To box."

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It would have been obvious to one of ordinary skill in the art to automatically create providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art. See MPEP 2144.04 and *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Claims 15 and 19 are also rejected since claims 15 and 19 recite substantially the same limitation as recited in claim 11.

Claims 12, 13, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Outlook 2000" in view of "Sams Teach Yourself Microsoft Outlook 2000 in 24 Hours" ("Teach Yourself").

Regarding claim 12, discloses the system according to claim 9.

"Outlook 2000" does not expressly disclose wherein the electronic message system is operative to automatically store in a user-assignable personal file folder associated with the sender of any read receipt report, said report received from the sender of said read receive report in response to a previously sent message, however, "Teach Yourself" does disclose these limitations (page 186, specifically "When you send your message, wouldn't it be nice to know when the recipient has read the message? With Outlook you can do this easily. When enabled,

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Outlook's advanced tracking feature sends you an email message when the recipient opens the mail").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since the references are directed to and disclose using the same electronic message system in order to efficiently send electronic messages, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Regarding claim 13, "Outlook 2000" and "Outlook 98" disclose the system according to claim 12.

"Outlook 2000" does not expressly disclose wherein said read receipt report is a dynamic, active read receipt report comprising a single file indicating read receipt status indicating which of a plurality of recipients of a previously sent message have and/or have not accessed said previously sent message, and wherein said read receipt report tracks a data and time of access by one of a plurality of recipients of said previously sent message. However, "Teach Yourself" does disclose these limitations (page 182, specifically "Click the

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Cc: button and select another recipient to whom you would like to send a "carbon copy" of the email."; page 186, specifically "When you send your message, wouldn't it be nice to know when the recipient has read the message? With Outlook you can do this easily. When enabled, Outlook's advanced tracking feature sends you an email message when the recipient opens the mail")

Claim 13 is rejected since the motivations regarding the obviousness of claim 12 also apply to claim 13.

Regarding claim 16, "Outlook 2000" discloses the system according to claim 9.

"Outlook 2000" does not expressly disclose wherein the system automatically stores a copy of an outgoing message upon being sent to a previously selected one of said user-assignable personal file folders, previously assigned and associated with a recipient of said outgoing message, however, "Teach Yourself" does disclose these limitations (page 225, specifically "A rule is a set of conditions and actions (at least one of each of required) that instructs Outlook how to handle messages."; page 227, specifically Figure 10.6, note "Which type of rule do you want to create?" and "Check messages after sending"; page 228, specifically Figure 10.8, note "What do you want me to do with the message?" and "move it to the specified folder" or "move a copy to the specified folder").

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Claim 16 is rejected since the motivations regarding the obviousness of claim 12 also apply to claim 16.

Claim 20 is also rejected since claim 20 recites substantially the same limitations as recited in claim 16.

Allowable Subject Matter

Claims 1-8 are allowed for the reasons indicated previously.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

gcn



JEFFREY PWU
PRIMARY EXAMINER